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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,713	12/21/2001	George Gillespie	092259-9008-00	5813

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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,713

Applicant(s)

GILLESPIE ET AL.

Examiner

Jennifer H Gay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4 and 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 17-30 is/are rejected.
- 7) ☒ Claim(s) 4,28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 4 and 28 are objected to because they are duplicate claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 17, 19, 22-24, 26, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Bixenman (US 6,343,651).

Regarding claim 17: Bixenman discloses a well screen cover that includes the following features:

- A tube (104) having a plurality of perforations therethrough (see col. 8, lines 1 and 2).
- A channel (152, see Figure 8) formed on an outer surface of the tube and along its length.

Regarding claim 19: The channel is defined on the outer surface of the perforated tube.

Regarding claim 22: Bixenman does not specifically disclose that press braking the channel along the length of the perforated tube forms the channel. However, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Regarding claim 23: The channel includes an open surface facing radially outward.

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Regarding claim 24: As seen in Figure 8, the channel includes sidewalls that are coupled to the inner surface of the perforated tube.

Regarding claims 26 and 27: The well screen cover includes a support ring (42) along the inner surface of the tube where the ring supports the tube and the channel.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bixenman (US 6,343,651) in view of Uban et al. (US 5,979,551).

Bixenman discloses all of the limitations of the above claims except for the tube being formed from a spirally wound strip of metal and being perforated. As seen in Figure 1, Uban et al. teaches an outer elongated tube (30) that is formed from a spirally wound metal strip (36) and is perforated (perforations (32)). It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the tube of Bixenman from a spirally wound strip of metal with perforations as taught by Uban et al. in order to have used a tube that was easily formed to the necessary length and allowed fluid flow therethrough.

6. Claims 20, 21, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bixenman (US 6,343,651).

Regarding claims 20 and 21: As seen in Figure 8, the channel of Bixenman includes a floor and sidewalls. Bixenman does not disclose what material the channel and/or the perforated tube are made from. However, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the channel and/or perforated tube from either the same or different materials, since it has been held to be within the general skill of

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a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 30: Bixenman discloses a well screen cover that includes the following features:

- A tube (104) having a plurality of perforations therethrough (see col. 8, lines 1 and 2).
- A channel (152, see Figure 8) formed on an outer surface of the tube and along its length.

Bixenman discloses all of the limitations of the above claims except for that the channel is made from the same material as the tube. However, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the channel and/or perforated tube from either the same or different materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bixenman (US 6,343,651) in view of Geske (US 4,096,911).

Bixenman discloses all of the limitations of the above claims except for the channel having sidewalls that are welded to an inner surface of the perforated tube.

Geske teaches a wellbore screen that includes a plurality of channels (14) that are welded (see Figure 4 and col. 3, lines 45-50) to an outer perforated tube (18).

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the channel of Bixenman such that it was welded to the inner surface of the perforated tube as taught by Geske in order to have secured the channel to the perforated tube in a known manner (see col. 2, lines 20-30). One would have been motivated to make such a combination because a channel securely held to the perforated tube would have been obtained, as taught by Geske.

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8. Claims 4, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bixenman (US 6,343,651) in view of Lembcke et al. (US 6,173,788).

Regarding claims 4 and 28: Bixenman discloses all of the limitations of the above claims except for using the channel to house fiber optic cable.

Lembcke et al. discloses a wellbore packer that includes a channel (14) formed on its outer surface. The channel is used to house control lines such as electrical cables, hydraulic lines, fiber optic cables, etc. (see col. 1, lines 12-19). The examiner notes a channel used to house control lines in a wellbore packer to be equivalent to a wellbore screen with such a channel.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used the channel of Bixenman to house fiber optic cable as taught by Lembcke et al. since the Lembcke et al. recognizes the equivalence of the electric control lines used in Bixenman and the fiber optic cable taught in Lembcke et al. for their use in the wellbores and the selection of any of these known equivalents to control downhole equipment would be within the level of ordinary skill in the art.

Regarding claim 29: The channel of Bixenman includes an open surface facing radially outward.

Response to Arguments

9. Applicant's arguments with respect to original claims 1-10 and new claims 17-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

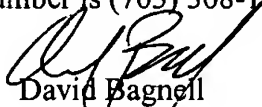
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

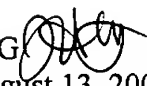
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


David Bagnell
Supervisory Patent Examiner
Art Unit 3672

JHG 
August 13, 2003